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| 09/870,185      | 05/30/2001  | Clark Chen           | INTL-0388-US (P8810) | 7287             |

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Timothy N. Trop  
TROP, PRUNER & HU, P.C.  
8554 KATY FWY, STE 100  
HOUSTON, TX 77024-1805

EXAMINER

HARTMAN JR, RONALD D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2121

DATE MAILED: 02/26/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/870,185

Applicant(s)

CHEN ET AL.

Examiner

Ronald D Hartman Jr.

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This action is in response to the Amendment filed on 12/8/2003.
2. Claims 1-8 and 10 are presented for further examination.

### *Response to Arguments*

3. The applicant asserts that Griffin does not teach a scroll wheel extending through the top and bottom sides of said display. The examiner respectfully disagrees. The applicant attention is directed to Figure 11 wherein the thumbwheel (element 4030) is clearly seen extending through the top side and bottom sides of the display device since it is angled in a way that allows it to extend through the planes embodied by the respective sides of the display device. Therefore, since this is the only argument with respect to claim 1, the previous rejection over Griffin is "maintained" and repeated herein.
4. The applicant then asserts that Griffin does not teach a scroll wheel that extends through both sides of the housing. This has already been explained above.
5. The applicant then asserts that Griffin does not teach two openings, however, this is a feature that is not in the claims so a response at this time is unnecessary.

6. For at least the aforementioned reasons, the rejection of claims 1-6 over Griffin is maintained and repeated herein (below) for the applicant's convenience.

***Minor Informalities***

7. Claim 7 needs a period at the end of the claim.

***Claim Objections***

8. Claim 4 should be reworded. Suggested claim language would be, "wherein said control is scrolling said display up and down."

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5; line 1, "near the edge" lacks antecedent basis.

Claims 5 and 7; lines 2 and 5, "the user's thumb" lacks antecedent basis.

Claims 5 and 7; lines 3 and 6, "the user's hand" lacks antecedent basis.

Claim 10; line 2, "the vertical display" lacks antecedent basis.

***Claim Rejections - 35 USC § 103 (new)***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 7-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osterhout, Des. 367, 890.

12. As per claim 7, Osterhout clearly teaches top and bottom sides to an electronic hand held game wherein a knob would obviously be used for controlling some aspect of the game (Figures 1-7). The knob would be rotated using the thumb and forefinger, as is conventional and well known in the art for effectuating some aspect of the game. Therefore, since the scroll wheel (knob) clearly “extends completely through the top and bottom sides” (Figures 6-7), and since all of the other claimed features of claim 7 are adequately suggested by way of Osterhout for the reasons explained above, the inclusion or modification of Osterhout to account for the obvious features claimed by way of claim 7 would have been obvious to one of ordinary skill in the art at the time the invention was made.

13. As per claim 8, although Osterhout does not teach an Internet connection, it would have been obvious so that a user could access and play online games, a form of gaming that is well known in the art. This would add greater flexibility and provide for a

more enjoyable gaming experience and therefore would have been obvious to one of ordinary skill in the art at the time the invention was made.

14. As per claim 10, although Osterhout does not teach adjusting a vertical display, it is a feature that would be obvious since if the user manipulates the knob, or wheel, some aspect of the vertical display will be affected and therefore the limitation is adequately suggested by Osterhout electronic hand held game design using a knob and this would have been obvious to one of ordinary skill in the art at the time the invention was made.

***Claim Rejections - 35 USC § 102 (maintained)***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

16. Claims 1 and 4-6 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Griffin et al, U.S Patent No. 6,489,950; having an effective filing date of 12/3/2002.

17. As per claim 1, Griffin teaches:

- providing a housing having a top and bottom sides (Figure 10);

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- providing a display in the housing (Figure 9 element 4012); and
- a scroll wheel to control the display (Figure 9 element 4002), the scroll wheel extending through the top and bottom sides of the housing (Figure 11; wherein the solid line just above element 4006 represents the middle of the device and the part above this line is the upper part of the device, and the part below this line is the bottom part of the device).

18. As per claim 4, Griffin teaches that the scroll wheel scrolls the display up and down (C6 L17-27 and C9 L60-63).

19. As per claims 5-6, Griffin teaches the device having a thumbwheel that is manipulate able by the thumb and forefinger of a user (claim 7; C18 L5-8).

***Claim Rejections - 35 USC § 103 (maintained)***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffin et al., U.S. Patent No. 6,489,950, in view of obviousness.

22. As per claim 2, although Griffin does not specifically teach the PDA type device being used for Internet use or for explicitly using the web, they are features that are well known in the art, especially within the confines of PDA type devices. Therefore, since using a PDA for accessing the Internet is well known and since its incorporation would have been obvious since it would provide the PDA type device with a convenient way of checking email or other aspects of web browsing functions, this feature and its incorporation into Griffin would have been obvious to one of ordinary skill in the art at the time the invention was made.

23. As per claim 3, Griffin teaches the device being wirelessly accessible (C5 L59-63).

### ***Conclusion***

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald D. Hartman Jr. whose telephone number is (703) 308-7001. The examiner normally works Mon. – Fri., 10:30 am – 8:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anil Khatri, can be reached at (703) 305-0282.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9618.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

(703) 872 9306

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Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Ronald D. Hartman Jr.  
Patent Examiner  
Art Unit 2121  
February 23, 2004

*Ramesh Patel*  
RAMESH PATEL  
PRIMARY EXAMINER  
*2/23/04*  
*For Anil Khatri*